

REMARKS

1. Summary of the Office Action

In the Final Office Action mailed September 7, 2005, the Examiner rejected claims 1-6, 11-15, 17-20, and 26-30 under 35 U.S.C. § 103 as being obvious over a combination of U.S. Patent No. 5,889,943 (Ji) and U.S. Patent No. 6,697,950 (Ko). The Examiner also rejected claims 7-10 and 16-25 under 35 U.S.C § 103 as being obvious over a combination of Ji, Ko, and U.S. Patent No. 6,701,440 (Kim).

2. Status of the Claims

Claims 1-36 are currently pending in this application. Of these, claims 1 and 15 are in independent format and the remainder are in dependent format. Applicant has amended claims 1-27 and 29 to further clarify the claimed subject matter, and added claims 31-36.

3. Response to Claim Rejections

a. Response to 35 U.S.C. § 112, ¶ 1 Rejections

The Examiner rejected claims 1-30 under 35 U.S.C. § 112, first paragraph. Applicant has amended claims 1 and 15 to remove the following element: “without scanning the electronic mail message for strings of characters which are known to be included in known viruses.” With these amendments, Applicant submits that each of the 35 U.S.C § 112 rejections have been traversed.

b. Response to 35 U.S.C. § 103 Rejections

As noted, claims 1 and 15 have been amended to further clarify the claimed subject matter. Specifically claim 1 has been amended to recite “removing any such script tags and operable program code from the message text, regardless of whether the script tags and operable program code are associated with a known virus.” And claim 15 has been amended to recite

“removing the script tags and operable program code from the message text, regardless of whether the script tags and operable program code are associated with a known virus.”

Applicant respectfully traverses the rejection of independent claims 1 and 15, because the combination of the cited references fails to teach each and every element of the independent claims or make the claims obvious. For instance, the combination of Ji and Ko fails to disclose “removing any such script tags and operable program code from the message text, regardless of whether the script tags and operable program code are associated with a known virus.”

Ji not only fails to disclose the above claim element, but also teaches away from the above claim element. To illustrate, Ji discloses taking a “corrective action” only when a virus is found. In particular, when an electronic mail message is detected and then downloaded, Ji discloses that the electronic mail message is scanned for viruses. Ji, col. 18, lines 34-45. And “[i]f the message is found to have a virus, the mail scanning apparatus **may then** take corrective action 1225” Ji, col. 18, lines 46-50 (emphasis added). For at least the reason Ji discloses taking “corrective action” only when a virus is found, Ji fails to disclose “removing any such script tags and operable program code from the message text, regardless of whether the script tags and operable program code are associated with a known virus.”

Ko fails to make up for the deficiency of Ji, and also teaches away from the above claim element. To illustrate, Ko discloses taking corrective action only when a suspect macro operation is found. In particular, Ko discloses receiving a document containing macro operations, and performing flow analysis on the macro operations to determine whether the macro operations contain a “suspect macro operation.” Ko, Abstract. If a suspect macro operation is found, then Ko discloses informing a user that the document contains suspect macro

operations, and receiving instructions from the user specifying an action to take with regards to the document. Ko, Abstract. For at least the reason that Ko discloses taking correction action only when a suspect macro operation is found, Ko fails to disclose “removing any such script tags and operable program code from the message text, regardless of whether the script tags and operable program code are associated with a known virus.”

Given that the combination of Ji and Ko fails to disclose each and every element of independent claims 1 and 15, the Examiner failed to establish a *prima facie* case of obviousness of the claims over the combination of references. Applicant respectfully requests the Examiner to withdraw the rejections of independent claims 1 and 15.

Without addressing the merits of the Examiner’s statements regarding the pending dependent claims, which are not conceded, Applicant points out that these claims depend from and include all of the limitations of at least one of independent claims 1 and 15. Therefore, Applicant’s dependent claims distinguish over the cited references for at least the same reasons discussed above with regard to independent claims 1 and 15. As such, Applicant respectfully requests that the Examiner withdraw the rejections of the pending dependent claims.

4. Conclusion

There may be other reasons for patentability for the claims, and Applicant does not waive those arguments by failing to assert them here. Applicant views the foregoing reasons as sufficient to establish that the claims are not anticipated or *prima facie* obvious. Applicant expressly reserves the right to make further arguments regarding patentability of the claims in future proceedings.

In view of the foregoing, Applicant submits that all of the pending claims are allowable. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims. Should the Examiner wish to discuss the case with the undersigned, the Examiner is invited to call the undersigned at (312) 913-3308.

Respectfully submitted,

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